

REMARKS

Applicants have reviewed this Application in light of the Final Office Action mailed June 18, 2009. Claims 17-22 are pending in this Application. Claims 17-22 were rejected. Claims 1-16 were previously cancelled. Claims 17, 18, 21, and 22 are amended herein. Applicants respectfully request reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 112

Claims 17 and 22 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description and enablement requirements, due to the language regarding "...services are consistent..." Although Applicants do not agree, Applicants have amended Claims 17 and 22 to more specifically recite that different mobile radio communication systems provide services of the same type to a mobile communication terminal. Therefore, Applicants request withdrawal of the rejections under 35 U.S.C. §112.

Rejections under 35 U.S.C. § 102

Claims 17 and 22 were rejected by the Examiner under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,613,213 issued to Marc C. Naddell et al. ("*Naddell*").

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that *Naddell* cannot anticipate Claims 17 and 22 as amended, because *Naddell* does not show all the elements of such claims as amended. For example, amended Claim 22 recites:

wherein at least two mobile radio communication systems provide the mobile communication terminal at least one service of the same service type; and

wherein the data records are used in the form of a plurality of service type lists corresponding to the plurality of different service types, the list for each particular service type listing services of the same type which are provided by any of said mobile radio networks.

As explained in Applicants' specification (emphasis added):

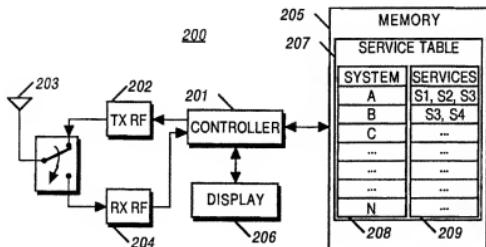
[0009] Preferably, the communication terminal is designed such that it respectively stores services of the same type which are repeatedly provided by the mobile radio networks using the data records in the communication terminal in the form of a service type list. In this embodiment, the data records, which are associated with one respective service type, are used to combine services of the same type within the communication terminal in the form of a list from which it is possible to select. It goes without saying that it is possible to provide a plurality of service types with a corresponding number of lists which are then all stored in the communication terminal.

Naddell does not teach these limitations. Rather, Naddell teaches at col. 3, lines 25-

40:

A block diagram of a communication unit 200 is shown in FIG. 2. ... Within this memory 205 is stored a service table 207 that includes a list of systems 208 and a list of services 209 that are associated with and/or currently available through those systems. For example, System A offers services S1, S2, and S3, System B offers services S3 and S4, and System C does not currently offer any services to this communication unit 108 in its present location. In accordance with the invention, the services listed in this service table are those services that are currently available. Because the communication unit 108 is not in the coverage area of System C as shown in FIG. 1, there are no services listed in the service table for System C. In addition, System D does not appear in the table because the communication unit is not affiliated with System D, and hence cannot access its services.

Fig. 2 of Naddell shows:



Thus, *Naddell* teaches a service table 207 that includes “a list of systems 208 and a list of services 209.” The list of systems 208 is simply a list of systems A, B, C, etc. that provide services available to a communications unit. The list of services 209 is simply a list of services provided by each system A, B, C, etc. Service table 207 does not include a “plurality of service type lists corresponding to [a] plurality of different service types,” much less where “the list for each particular service type listing services of the same type which are provided by any of said mobile radio networks.” Assuming for the sake of argument that S1, S2, S3, etc. indicate different service types, neither list 208 nor list 209 corresponds to a particular service type. Moreover, neither list 208 nor list 209 is a list of services of one particular type (e.g., S1). List 208 does not list services, and list 209 lists all types of services provided by any of the systems. Therefore, *Naddell* cannot teach the limitations of amended Claim 22 recited above.

In addition, *Naddell* also cannot teach similar limitations of amended Claim 17, such as “wherein each of the at least two mobile radio communication systems provides the mobile communication terminal at least one service of the same service type” and “a plurality of service type lists corresponding to the plurality of different service types, the list for each particular service type comprising services of the same particular type which are provided by any of said mobile radio networks.”

For at least these reasons, Applicants respectfully request reconsideration and allowance of amended Claims 17 and 22, as well as claims 18-21 that depend from Claim 17.

Rejections under 35 U.S.C. § 103

Dependent Claims 18-21 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Naddell* in view of U.S. Patent No. 5,903,832 issued to Jorma Seppanen et al. (“*Seppanen*”).

Applicants submit that claims 18-21 are allowable at least because they depend from Claim 17, shown above to be allowable. Accordingly, Applicants respectfully request allowance of dependent claims 18-21.

CONCLUSION

Applicants have now made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicants respectfully request reconsideration of the pending claims.

Applicants submit a Request for Continued Examination. The Commissioner is authorized to charge the fee of \$810.00 required to Deposit Account 50-4871 of King & Spalding LLP in order to effectuate this filing.

Applicants believe no other fees are due; however, should the Commissioner deem that any additional fees are due, including any fees for any additional extensions of time, the Commissioner is hereby authorized to debit said fees from deposit account number 50-4871.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicants' attorney at 512.457.2030.

Respectfully submitted,
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